

REMARKS

Claims 1-22 are canceled. Claims 35 and 37 – 42 are withdrawn. Claims 23 – 42 are pending. Claim 23 has been amended.

Examiner Interview

Applicant would like to thank Examiner Melody Burch for the time and courtesy extended to Applicant's representative James M McPherson during an Examiner interview conducted on November 4th, 2011. During that interview, Examiner Burch agreed that reference US 2005/0218856 is not a prior art reference and could not be used to formulate rejections to the claims of the present application. Examiner Burch further agreed that, due to this error, an immediate subsequent Office Action could not be made final, should one be issued.

Applicant's Representative and Examiner Burch further discussed distinguishing features between the present invention and the prior art of record. In particular, Examiner Burch indicated that amending claim 23 to recite a one piece valve block would also overcome the current rejection and is supported by the specification.

Specification Objections – 35 USC §132(a)

The Specification, as previously amended, is currently being objected to under 35 U.S.C. 132(a) for including new matter. Specifically, the objection is based upon an incorporation by reference statement added on page 1, line 4, of the Specification, which was added with the last amendment filed on August 1, 2011. The Examiner asserts that the addition of this incorporation by reference statement to PCT/EP2004/051682 and German patent application no. 10335923.0 adds new matter. Applicant respectfully disagrees.

At the onset, Applicant notes that MPEP § 201.17 and specifically 37 CFR § 1.57 relate to the incorporation by reference of external information to the Specification. This provision applies to U.S. patent applications filed on or after September 21, 2004. Applicant notes that 37 CFR § 1.57 (a) recites (underlining added):

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted

portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

Applicant notes that the present application includes a 35 USC § 371 (c) filing date of January 4, 2007. Accordingly, the provisions of MPEP § 201.17 and 37 CFR § 1.57 apply to the present application. With respect to the 37 CFR § 1.57 provision of "the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application", Applicant notes that in the originally filed Application Data Sheet of February 6, 2006, the present application had claimed priority to PCT International patent application no. PCT/EP2004/051682, filed July 30, 2004, and to German patent application no. 10335923.0, filed August 6, 2003.

In view of the foregoing, an incorporation by reference to PCT/EP2004/051682 and German patent application no. 10335923.0 has already been effectively made. As such, the actual recitation of PCT/EP2004/051682 and German patent application no. 10335923.0 within the Specification cannot be considered new matter. Applicant believes the objection to the Specification under 35 U.S.C. 132(a) has been traversed.

Claim Rejections – 35 USC §112

Claims 23 - 34 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 23, along with dependent claims 24 - 34 and 36, were rejected for including contradictory phrases "a bake pressure sensor (8)", recited in line 2, and "the brake pressure sensor (2)", recited in lines 18 and 20.

Without acquiescing to the asserted rejection, Applicant has simple amended claim 23, line 2, to replace "(8)" with "(2)". Applicant believes the foregoing amendment renders the rejection under 35 U.S.C. 112, second paragraph, moot.

Claim Rejections – 35 USC §103

Claims 23, 29, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5568962, to Enomoto et al., in view of US Patent 5069508, to Maehara, and 6007162, to Hinz et al., and US Patent 3133611, to Halsey et al., and US Patent Application

2005/0218856, to Okano. Dependent claims 25 - 28, 30, 31, 33 and 34 are also rejected under 35 U.S.C. 103(a) as being unpatentable over the above referenced patents and in further view of one or more of US 6354674, to Iwamoto et al., 5971503, to Joyce et al., 5219442, to Burgdorf et al, and 4736992, to Hendrickson. Applicant respectfully disagrees.

Rejection of claim 23 and dependent claims 24 -34 and 36 are all based upon the teachings of US Patent Application 2005/0218856, to Okano, which has a filing date of March 3, 2005 and a priority date of March 30, 2004. This reference was discovered, in a prior art search performed by the Examiner in response to Applicant's amendment to obviate the current rejection.

As previously noted above, the present application claims priority to PCT International patent application no. PCT/EP2004/051682, filed July 30, 2004, which further claims priority to German patent application no. 10335923.0, filed August 6, 2003. As this date anticipates the earliest priority date of US Patent Application 2005/0218856, to Okano, this reference cannot be used as a prior art reference and a *prima facie* has not been established. Accordingly, the rejection of claim 23 and dependent claims 24 -34 and 36, under 35 U.S.C. 103(a), has been traversed and/or rendered moot.

Notwithstanding, pursuant to the Examiner Interview, Applicant has amended claim 23 to recite a one piece valve block. Applicant has further amended independent claim 23 to recite a brake pressure sensor (2) including a pressure space (3) and a pressure sensor (8) in fluid communication with the pressure space (3) to measure pressure levels within the pressure space (3), which can be actuated by a brake pedal, the pressure space (3) having a variable volume defined in part by a moveable piston connected to the brake pedal. Applicant notes that not only does Enomoto fail to teach or suggest these features, but modifying Enomoto to include these features would change the principle of operation of Enomoto, if not render the Enomoto system unsatisfactory for its intended purpose. Applicant notes that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Claim Amendments

Applicant has further amended claims 23 and 34 to correct previously undiscovered punctuation error and misspellings.

CONCLUSION

Accordingly, Applicant believes that the claims as amended overcome the raised objections and rejections and are in a condition for allowance. Applicant does not believe any fees are due in connection with the filing of this Response. If, however, Applicant is in error and there are additional fees due, including any extension fees, please charge all such required fees to Deposit Account 50-2570.

Respectfully submitted,

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